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Jon Dudas, Director
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Dear Director Dudas:

By the time you receive this letter, it will have been exactly a year since we filed all of the necessary papers with the USPTO to enter the US national stage in international application number PCT/IB04/52005. During this twelve-month period, so far as I can see, USPTO has failed to do anything at all to get this case into the hands of an Examiner. The case has not even now been given a "371 date" and has not been released to the Examining Corps. It does not, after a year, even have a Filing Receipt.

This delay seems particularly unfortunate when one considers that six months ago we wrote a letter to Commissioner Doll about this problem of no Filing Receipt.

While this period of inaction by USPTO is longer than usual for entry into the US national stage, the period of inaction by USPTO in most other national-stage-entry cases does average anywhere from eight to ten months. This is disappointing especially when compared with the USPTO's handling of newly filed cases under 35 USC section 111(a), where USPTO usually manages to release the application to the Examining Corps within three or four months of filing. Such inaction by the USPTO in national-stage cases seems ill-advised as a general matter, assuming that USPTO has a goal of serving its customers at at least a minimum level of service.

I am under the impression that USPTO has chosen to budget an amount of money to PCT Operations that is inadequate to permit timely handling of national-stage papers. In those cases (like the present case) where USPTO already found all the claims to be patentable, it seems particularly ill-advised for USPTO to choose to budget an inadequate amount of money for this function. Such a decision by USPTO to fund national-stage entry operations inadequately leads to a situation where the national-stage application will reach the Examining Corps only a year or more after the Examining Corps already examined the same case in the international stage. Such a delay leads to a complete loss of the efficient examination that could have occurred had the Examining Corps in the national stage been able to carry out their duties while the international-stage work was fresh in mind.

37 CFR section 1.496 requires USPTO to examine a case like this one (a case that USPTO already found to be patentable) "out of order". The reason for this is simple and clear -- it is more efficient. It reduces pendency by eliminating from the Examiner's docket a case that is easy to examine and to allow.

Here, I see no indication that USPTO has complied with Rule 496.

It would be very helpful if USPTO were to budget sufficient money to PCT Operations that national-stage entry in all cases can be handled in a time frame consistent with the time frame under which 111(a) cases get handled.

If USPTO cannot or will not do that, common sense suggests at least that cases under Rule 496 ought to be "fast-tracked" through the national-stage process so that they reach the Examining Corps promptly instead of being delayed for a year or more (like this case). In that way the Examining Corps could more quickly dispose of those easy-to-examine cases, thereby reducing overall pendency.

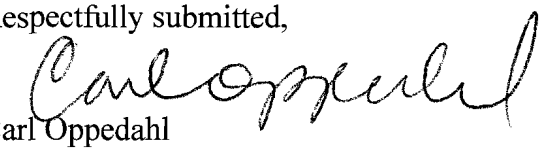
There is one last matter calling for your assistance. My recent discussions with many Examiners who have Rule-496 cases on their dockets have led me to believe that USPTO's present workflow practices include nothing at all that would indicate to an Examiner that a case on the Examiner's docket is (because of Rule 496) supposed to be examined "out of order". Quite consistently, the Examiner in such a case will tell me that he or she has no idea that the case is supposed to be examined "out of order" and instead tells me that the case will only get examined after all of the other cases on the Examiner's docket. When this happens we then talk to the SPE, who likewise indicates that there is no way the Examiner could possibly know the case is supposed to be examined "out of order". The Examiners tell me that they are trained that they must take the docket information in Palm as authoritative regarding the sequence of examination, and they tell me that nothing in Palm gives any indication of the Rule-496 status of a case.

From the customer's point of view, the official Filing Receipts in Rule-496 cases always say that the case will be examined "in order". Whenever we encounter this, we ask for a corrected Filing Receipt reflecting the fact that the case is to be examined "out of order", but thus far USPTO has never issued a corrected Filing Receipt showing the correct Rule 496 order of examination for such a case.

I suggest in the strongest terms that if Palm indeed never tells the Examiner about the Rule-496 status of a case, and if Examiners are being trained not to pay any attention to anything but Palm when choosing the order in which to examine cases, then USPTO is in complete failure to comply with Rule 496.

I look forward to hearing back from you about these matters.

Respectfully submitted,



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